



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,752	02/02/2001	Takashi Yamaguchi	0649-0772P	6901

2292 7590 06/14/2002

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 06/14/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/27/3752

Applicant(s)

Yamaguchi et al

Examiner

T. Yoon

Group/Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 6-5-02

☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1714

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recited "wherein the composition is substantially free of ethylenically unsaturated group-containing monomers" does not have support in the specification and thus constitutes NEW MATTER. Negative limitation must have an exclusive support in the original specification, *Ex parte Grasselli*, 231 USPQ, 393-394.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hefner, Jr. et al (US 4,524,178) in view of JP 63-305160.

Art Unit: 1714

Rejection is maintained for reason of record and following.

Contrary to applicant's assertion, the recited "wherein the composition is substantially free of ethylenically unsaturated group-containing monomers" permits the presence of vinyl compound since the specification failed to define said substantially free and the examiner interprets it being less than 50 wt%. The recitation of "consisting essentially of" in claim 8 alone cannot overcome the rejection based on the art reciting "comprising". See *In re De Lajarte*, 337 F2d 870, 143 USPQ 256 (CCPA, 1964); When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of", applicant has the burden of showing the basic and novel characteristics of his composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition.

Note that Hefner, Jr. et al teach the instant bis(hydroxypropyl)bisphenol A, and JP is cited to show the amount (mol%) of an alkylene oxide adduct in an unsaturated polyester and polyesteramide regardless of a hydrogenation. Besides, Hefner, Jr. et al teach employing said adduct, bis(hydroxypropyl)bisphenol A and a mixture of polyols at col. 3, lines 36-46, and thus the utilization of the instant mol% is a *prima facie* obviousness even without JP.

Applicant asserts unexpected results, the invention does not have the smell and safety problems, however, applicant teaches that even comparative examples have no irritating smell at page 15, line 21. Thus, such assertion has no probative value. Besides, the comparative example 1 having applicant's claimed upper limit, 49.5 mol% of the adduct, exhibits inferior properties as

Application/Control Number: 09/773,752

Page 5

Art Unit: 1714

Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/June 12, 2002



TAE H. YOON
PRIMARY EXAMINER



Creation date: 06-08-2003
Indexing Officer: HNGUYEN28 - HAO NGUYEN
Team: OIPEBackFileIndexing
Dossier: 09773752

Legal Date: 29-08-2002

No.	Doccode	Number of pages
1	A...	1
2	CLM	1
3	REM	11
4	LET.	2

Total number of pages: 15

Remarks:

Order of re-scan issued on